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# TRANSMITTAL FORM

*(to be used for all correspondence after initial filing)*

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| Total Number of Pages in This Submission | 11 |

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| Application Number | 09/523,056 |
| Filing Date | March 10, 2000 |
| First Named Inventor | Lamberton et al. |
| Art Unit | 2154 |
| Examiner Name | Dustin Nguyen |
| Attorney Docket Number | FR9-99-008 |

## ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/ Incomplete Application
  - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
  - ☐ Landscape Table on CD
- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☑ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☑ Other Enclosure(s) (please Identify below):

Request for Reinstatement of Appeal

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|---|---|---|---|
| Firm Name | Winstead Sechrest & Minick P.C. | | |
| Signature | | | |
| Printed name | Robert A. Voigt, Jr. | | |
| Date | March 18, 2005 | Reg. No. | 47,159 |

## CERTIFICATE OF TRANSMISSION/MAILING

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| Signature | Serena Beller | | |
| Typed or printed name | Serena Beller | Date | March 18, 2005 |

FR9-99-008 PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| In re Application of: Lamberton et al. | : | Before the Examiner: Nguyen, Dustin |
| Serial No.: 09/523,056 | : | Group Art Unit: 2154 |
| Filed: March 10, 2000 | : | |
| | : | IBM Corporation |
| Title: SYSTEM AND METHOD FOR IMPROVED LOAD BALANCING AND HIGH AVAILABILITY IN A DATA PROCESSING SYSTEM HAVING AN IP HOST WITH A MARP LAYER | : | P.O. Box 12915<br>Dept. 9CCA, Bldg. 002-2<br>Research Triangle Park, NC 27709 |

## REQUEST FOR REINSTATEMENT OF APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action having a mailing date of January 4, 2005, reopening prosecution of the above-referenced Application, Applicants respectfully request reinstatement of the Appeal based on the Amended Appeal Brief filed on October 7, 2004 and the Notice of Appeal filed on April 26, 2004.

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**CERTIFICATION UNDER 37 C.F.R. §1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 18, 2005.

Serena Beller
Signature

Serena Beller
*(Printed name of person certifying)*

A supplemental appeal brief is filed herewith.

FEE DEFICIENCY

*NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.*

☒ If any additional extension and/or fee is required, this is a request therefore and to charge Account No. 50-0563 (FR9-99-008).

AND/OR

☒ If any additional fee for claims is required, charge Account No. 50-0563 (FR9-99-008).

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

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By: _____

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

| | | |
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| In re Application of: Lamberton et al. | : | Before the Examiner: Nguyen, Dustin |
| Serial No.: 09/523,056 | : | Group Art Unit: 2154 |
| Filed: March 10, 2000 | : | |
| | : | IBM Corporation |
| Title: SYSTEM AND METHOD FOR IMPROVED LOAD BALANCING AND HIGH AVAILABILITY IN A DATA PROCESSING SYSTEM HAVING AN IP HOST WITH A MARP LAYER | : | P.O. Box 12915 Dept. 9CCA, Bldg. 002-2 Research Triangle Park, NC 27709 |

## SUPPLEMENTAL APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This supplemental brief is being submitted pursuant to 37 C.F.R. §41.37.

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**CERTIFICATION UNDER 37 C.F.R. §1.8**

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Serena Beller
Signature

Serena Beller
*(Printed name of person certifying)*

## I. INCORPORATION BY REFERENCE

Appellants hereby incorporate herein by reference Sections I-V and VIII of Appellant's Amended Appeal Brief mailed on October 7, 2004.

## II. NEW GROUND OF REJECTIONS TO BE REVIEWED ON APPEAL

Claims 1-16 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of copending Application No. 09/537,242. Claims 1-16 stand rejected under the judicially created doctrine of obviousness-type double patenting in view of Lamberton et al. (U.S. Patent No. 6,754,220) (hereinafter "Lamberton"). Claims 5 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Li et al. (U.S. Patent No. 5,473,599) (hereinafter "Li").

## III. ADDITIONAL ARGUMENTS

### A. The provisional double patenting rejection rejecting claims 1-16 should be withdrawn if the provisional double patenting rejection is the only rejection remaining in the application.

The Examiner has provisionally rejected claims 1-16 under the judicially created doctrine of obviousness-type double patenting in view of copending Application No. 09/537,242. Office Action (mailing date of January 4, 2005), page 3. Appellants note that if the "provisional" double patenting rejection is the only rejection remaining in an application (either the present application or Application No. 09/537,242), then the Examiner should withdraw the rejection and permit that application to issue as a patent. M.P.E.P. §804. The "provisional" double patenting rejection may then be converted into a double patenting rejection in the other application at the time the one application issues as a patent. M.P.E.P. §804.

B. Claims 1-16 are improperly rejected under the judicially created doctrine of obviousness-type double patenting in view of Lamberton.

The Examiner has rejected claims 1-16 based on nonstatutory double patenting citing claims 1-24 of U.S. Patent No. 6,754,220 as claiming common subject matter of claims 1-16. Office Action (mailing date of January 4, 2005), page 2.

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is—does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? M.P.E.P. §804. A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (C.C.P.A. 1967); M.P.E.P. §804. Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. M.P.E.P. §804. However, the Examiner has not made any such inquiry. The Examiner has not made any factual inquiries (1) to determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (2) to determine the differences between the scope and content of the patent claim and the prior art as determined in (1) and the claim in the application at issue; (3) to

determine the level of ordinary skill in the art; and (4) to evaluate any objective indicia of nonobviousness. M.P.E.P. §804.

Any obviousness-type double patenting rejection should make clear the differences between the inventions defined by the conflicting claims—a claim in the patent compared to a claim in the application. M.P.E.P. §804. The Examiner has not made clear the differences between the inventions claimed in the application and the claims in the cited patent. The Examiner has not cited to any passage in U.S. Patent No. 6,754,220 indicating which limitations of the instant application are alleged to have been taught in U.S. Patent No. 6,754,220 and which limitations in the instant application are not taught in U.S. Patent No. 6,754,220.

Further, any obviousness-type double patenting rejection should include reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. M.P.E.P. §804. Simply stating that the "mediator" of U.S. Patent No. 6,754,220 "performs the same function of selecting a router for forwarding data information" as disclosed in the application is insufficient to establish a reason as to why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent. Office Action (mailing date of January 4, 2005), page 5. The Examiner has not cited to any passage in U.S. Patent No. 6,754,220 indicating that the "mediator" performs any of the limitations as recited in claims 1-16 in the instant application. Further, with respect to the limitations recited in claims 1-16 in the instant application not taught in U.S. Patent No. 6,754,220, the Examiner has not provided any evidence as to why one of ordinary skill in the art would conclude that these limitations not taught in U.S. Patent No. 6,754,220 would have been an obvious variation of the invention defined in U.S. Patent No. 6,754,220.

Consequently, in view of the foregoing, the Examiner has not provided a basis for an obviousness-type double patenting rejection of claims 1-16. M.P.E.P. §804.

C. Claims 5 and 9 are not properly rejected under 35 U.S.C. §102(b) as being anticipated by Li.

The Examiner has rejected claims 5 and 9 under 35 U.S.C. §102(b) as being anticipated by Li. Office Action (mailing date of January 4, 2005), page 6. Appellants respectfully traverse these rejections for at least the reasons stated below.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Appellants respectfully assert that Li does not disclose "selecting a router by an IP host in a data transmission system transmitting packetized data from said IP host having at least an IP layer and a network layer to a plurality of workstations by an intermediary of an IP network, and wherein said IP host is coupled to said IP network via a layer 2 network interfacing said IP network by a set of routers" as recited in claim 5 and similarly in claim 9. The Examiner has not cited to any passage in Li as disclosing selecting a router by an IP host in a data transmission system transmitting packetized data from the IP host having at least an IP layer and a network layer to a plurality of workstations by an intermediary of an IP network. Neither has the Examiner cited to any passage in Li as disclosing an IP host coupled to an IP network via a layer 2 network interfacing the IP network by a set of routers. The Examiner is reminded that in order to establish a *prima facie* case of anticipation, the Examiner must identify a reference that expressly or inherently describes each and every claim element as set forth in the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. §2131. Since the Examiner has not identified passages in Li as disclosing the above-

cited claim limitations, the Examiner has not established a *prima facie* case of anticipation in rejecting claims 5 and 9. M.P.E.P. §2131.

Appellants further assert that Li does not disclose "determining a list of active candidate routers from said list of candidate routers, said list of active candidate routers determined before selecting, from said set of routers, said router to be used for transmitting said packetized data" as recited in claim 5 and similarly in claim 9. The Examiner cites Figures 2A-B and column 6, line 9 – column 7, line 29 of Li as disclosing the above-cited claim limitation. Office Action (mailing date of January 4, 2005), page 6. Appellants respectfully traverse and assert that Li instead discloses a network segment that includes a host on a LAN, a group of routers on a cable and a virtual router. Column 6, lines 27-29. As illustrated in Figure 2A, routers R1, R2 and R3 are connected to host H via cable 120 and bi-directional line 74. Further, as illustrated in Figure 2A, host H is coupled to virtual router R4 via cable 120 and bi-directional line 74. Li further discloses that at any one time, one of the routers R1, R2 or $3 assume the state of an active router, a condition requiring that it emulates the virtual router R4. Column 6, lines 40-42. Li further discloses that the host H is configured to point to virtual router R4, regarding of which real router (R1, R2 or R3) is currently emulating it. Column 6, lines 42-44. Li further discloses that when the host H needs to send data packets outside of the LAN, it directs them to virtual router R4. Column 6, lines 44-46. Li further discloses that a virtual router is defined by virtual MAC layer and network layer addresses which are shared by a group of routers running the protocol of Li's invention. Column 6, lines 46-49. Li further discloses that one of the routers in the group (R1, R2 or R3) assumes the state of standby (or backup) router. Column 6, lines 58-59. Li further discloses that when the standby router detects that the active router has failed, it takes over as the active router by adopting the group's MAC and IP addresses. Column 6, lines 59-62. Li further discloses that a new standby router is automatically selected from among the other routers in the group. Column 6, lines 62-64.

Thus, Li discloses a group of routers associated with a host where the group of routers includes a router designated as an "active router" and another router in the group is designated as a "standby" or "backup" router. Further, one of the routers in the group is a virtual router. The host directs data packets to be sent outside of the LAN to the virtual router.

There is no language in the cited passage of Li that discloses determining a list of active candidate routers from a list of candidate routers. The Examiner has not specifically indicated in Li as to what constitutes the list of candidate routers that were determined from the set of routers. If the Examiner is asserting that routers R1-R7, as illustrated in Figure 2B, discloses a list of routers and that routers R1-R3, as illustrated in Figure 2B, disclose a list of candidate routers, then which routers of R1-R3 comprise the list of active candidate routers. Li discloses that one of the routers in the group is an "active" router, but the claim limitation requires a list of active candidate routers. Furthermore, out of the list of candidate routers, a router is selected to transmit packetized data. Li discloses that the virtual router, e.g., virtual router R4 in the example of Figure 2A, receives the data packets that are to be transmitted outside of the LAN from the host. However, there is no language that the virtual router is from the list of candidate routers. Thus, Li does not disclose all of the limitations of claims 5 and 9, and thus Li does not anticipate claims 5 and 9. M.P.E.P. §2131.

Appellants further assert that Li does not disclose "selecting said router to be used for transmitting said packetized data from said list of active candidate routers" as recited in claim 5 and similarly in claim 9. The Examiner cites the Abstract and column 2, lines 16-31 of Li as disclosing the above-cited claim limitation. Office Action (mailing date of January 4, 2005), page 6. Appellants respectfully traverse. As stated above, Li discloses that the host is configured to send out of its LAN packets to a virtual router. Abstract; Column 2, lines 18-20. There is no language in Li that discloses that the virtual router used to send out packets from a LAN is a

router selected from a list of active candidate routers. Thus, Li does not disclose all of the limitations of claims 5 and 9, and thus Li does not anticipate claims 5 and 9. M.P.E.P. §2131.

## IV. CONCLUSION

For at least the reasons stated above and in the Amended Appeal Brief filed by Appellants on October 7, 2004, the rejections of claims 1-16 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-16.

Respectfully submitted,
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